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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,293	05/25/2001	Michael E. Aufricht	1933.0010008	3536
26111 7590 07/17/2007 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER DURAN, ARTHUR D	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/864,293	Applicant(s) AUFRICHT ET AL.	
	Examiner Arthur Duran	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 16-26 and 46-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 16-26, and 46-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/11/07</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-11, 16-26, and 46-58 have been examined.

Response to Amendment

2. The Amendment filed on 6/20/07 is sufficient to overcome the prior rejection.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/11/07 has been entered.

Priority

3. Applicant's statement that the present application 09/864,293 is a Continuation-In-Part (CIP) of Applications 09/559,964 and 09/393,390 is noted. However, the Examiner notes that this Application, 09/864,293, does not benefit from an earlier filing date. There is inadequate support under 35 USC 112 in the CIP applications. The CIP applications do not disclose any pre-populating of an advertisement with address location information related to the user. Also, 09/393,390 does not disclose any color depth optimizing features. Hence, the present application, 09/864,293, has a priority date to the present application's filing date which is 5/25/2001.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4, 6, 7, 9-11, 16, 17, 19, 21, 22, 24-26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw (6,516,341) in view of Gerace (5,848,396) in view of Buckingham (6,961,776).

Claim 1, 2, 4, 6, 16, 17, 19, 21: Shaw discloses computer implemented method for placing advertisements with interactive content on devices, comprising the steps of:

- (1) displaying an advertisement with interactive content on a device (Fig. 10),
- (2) pre-populating at least one field of the advertisement with address location information relating to the user of the device;
- (3) conditionally forwarding the at least one pre-populated field to an entity associated with the advertisement to provide information regarding the user to the entity:

“(39) By clicking on the banner advertisement 800, the user may be provided with an e-mail message template to create an e-mail message (as described in connection with FIG. 12 below), having the addressee already filled in with the e-mail address of a company associated with the subject matter of the current banner advertisement 800. In this manner, the user may, for example, provide comments to the company regarding the subject matter of the banner

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advertisement 800 or request further information. Alternatively, clicking on the banner advertisement 800 may cause an e-mail message to be automatically completed (including the message) and either transmitted immediately or stored in the user's "outbox" folder (described later). The message may merely identify the user to the addressee of the e-mail message as someone interested in the subject matter of the banner advertisement 800 (col 13, line 55-col 14, line 5);

(23) The first time that the client computer software is executed on the client computer 101 (and whenever a user wishes to establish a new account with the server system 104), the client program performs various function intended to establish a new account for the user. In the representative embodiment, the first step is to collect new account information (step 301). At the request of the client program, the user inputs name, address, telephone number and other identification data. This information is stored on storage device 206 (col 11, lines 48-60);

(30) The user's responses (i.e., the completed member profile) are stored on the client computer 101 storage device 206 for future transmission to the server system 104. In the representative embodiment, the member profile is transmitted to the server system 104 when the user first sends or receives e-mail. . .The member profile can be updated by the user and will then be transmitted to the server system 104 when the user next connects with the server system 104 to sent or receive e-mail messages (col 12, lines 46-60);

(32) It will be appreciated that in alternative embodiments, the member profile may be transmitted to the server system 104 at step 304 along with the selected e-mail address and password" (col 12, lines 62-67).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that user address information can be sent along with the pre-filled email. One would have been motivated to do this in order to provide relevant user information for better identification, profiling, and tracking of the user.

Shaw further discloses caching content (col 2, lines 25-35).

Therefore, it would be obvious to one skilled in the art that Shaw's content which is forwarded can be done so at a later time. One would be motivated to do this in order to allow greater off-line utilization.

Additionally, Shaw further discloses utilizing an ISP provider:

“(10) There are a number of ways that a user can connect to the Internet to send and receive e-mail. A user can have an account with a proprietary on-line network, such as, for example, Prodigy, America Online, CompuServe or Microsoft Network. Using a computer with a modem, the user dials up the on-line network's access number and connects to the on-line network. The user can then send and receive e-mail to and from other users of the on-line network and, provided that the on-line network is connected to the Internet, with those having an Internet e-mail address. An alternative method to connect with the Internet is via an Internet Service Provider. Using a modem, the user dials the access number of the Internet Service Provider, and establishes a connection with a computer "directly" connected to or part of the Internet. The user can then operate an e-mail program, such as Eudora, to send and receive e-mail over the Internet” (col 1, line 55-col 2, line 5).

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Shaw discloses advertising while online or utilizing the Internet or utilizing websites:

“(11) In many existing systems, users read and write e-mail while on-line, i.e., while connected to the on-line network or the Internet Service Provider.

Costs of operating the on-line network (including communication and hardware costs) are higher when users are connected to the network. Also, some on-line networks and Internet Access Providers charge per minute of connect time.

Accordingly, it is more cost effective if users read and write e-mail messages when off-line (e.g., when not connected to the on-line network).

(12) Some existing on-line services display advertising to users. For example, advertisements are shown on part of the screen to users of the America Online network. When accessing certain World Wide Web sites on the Internet, advertisements are often included as part of the web page seen by the user. Often in such systems, each user accessing a certain screen or site is shown the same advertisement. Sophisticated systems have the capability to change the advertisement after a certain period of time. However, in such systems the user must remain connected to the network to see the replacement advertisement” (col 2, lines 5-25).

Shaw discloses advertisements with different capabilities or features:

“(35) In the representative embodiment there are two types of advertisements. Banner advertisements 800 are displayed at step 501 when the user is reading and creating e-mail messages, or performing other administrative tasks, e.g., moving e-mail messages between folders. In the representative embodiment,

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banner advertisements 800 are displayed in a box at the top right side of the window (see FIGS. 8 and 12). Showcase advertisements are displayed whenever the user is attempting to establish a connection with the server system 104 and when information is being transferred between the client computer 101 and the server system 104. The banner and showcase advertisements may be textual, graphical, or video data (or combinations thereof) and may be stored in a standard compressed data format, such as JPEG or MPEG, or in a proprietary format, or in an uncompressed format. Typically, advertisements are simple graphics files. Sounds may also be included” (col 13, lines 15-30).

Shaw discloses targeting a user based on a user profile or user characteristics:

“(36) Targeted Advertisements: When first using the system of the present invention, the user completes a member profile (or survey) at the client computer. The member profile records information about the user, e.g., hobbies, interests, employment, education, sports, demographics, etc. The client program transmits the member profile to the server system when the user's client program first establishes a connection with the server system (e.g., on initial sign-up). The member profile is stored in the database management system of the server system” (col 5, lines 5-15).

Shaw does not explicitly disclose that the advertisement is at least a portion of a web page adapted for the device.

However, Gerace discloses profiling users and tracking user characteristics (Fig. 3b) and that characteristics of the user device can be tracked and recorded (Fig. 3c) and tailoring an

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advertisement to a user based on the user device or that the advertisement is at least a portion of a web page adapted for the device:

“(18) Also for each user, there is a User Computer Object 37b and a User Interface Object 37c. For each user's computer, User Computer Object 37b provides an indication of the limitations and capabilities of the user's computer system. For example, User Computer Object 37b lists whether the user's system provides audio and/or video display, and what Web browser software is utilized by the user's system. An outline of the table/data set of a User Computer Object 37b in the preferred embodiment is illustrated in FIG. 3c (col 6, lines 13-22).

(53)...Ad Object 33d also provides references to graphic, sound, and multimedia portions of an advertisement. A text-only format of an advertisement is used for users receiving messages on their own E-mail service or on a text-only browser (e.g., Links systems for VAX/VMS operating systems) rather than through the messaging feature of program 31” (col 12, lines 47-55).

Gerace further discloses advertisements with varying characteristics:

“(19) The Sponsor Object categorizes advertisement or other sponsor provided information according to content and presentation, including colors used, size, shape, and whether audio and/or video components are involved. An advertiser profile building routine automates the process of identifying colors, size, shape, and whether video and/or audio are involved” (col 2, lines 5-10).

Gerace further discloses advertisements tailored to the user preferences/characteristics:

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“(13) With respect to the advertisement module 75, program controller 79 obtains sponsor submitted advertisements from module 75 and generates a screen view formatted according to user preferences as determined from the psychographic profile in the user profiling member 73. That is, program controller 79 enables display of advertisements customized to the user, as to content and presentation (i.e., colors used, orientation on the screen, audio/video components, and the like). Program controller 79 obtains the content from the advertisement module 75 and the presentation details for the subject user from the user profiling member 73” (col 5, lines 15-25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gerace's tailoring or targeting an advertisement to a user based on user characteristics where user characteristics can include user device information to Shaw's targeting a user based on user characteristics and advertisements with different presentation capabilities. One would have been motivated to do this in order to present the advertisement in a format that is accessible and of interest to the user.

Also, Shaw and Gerace disclose utilizing computers and utilizing the Internet as a communications medium. And, the MPEP 2144.04 IV.A. states that a change in size is an obvious variation of the prior art and the MPEP 2144.04 V.A. states that making the device portable is an obvious variation of the prior art and the MPEP 2144.04 V.C. states that making the device separable is an obvious variation of the prior art. Therefore, it would be obvious to one skilled in the art that the computer of Shaw and Gerace that can be located in a variety of locations that communicates utilizing the Internet can be hand-held and/or portable. One would

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be motivated to do this in order to increase the utilization of the computer when traveling (as stated in both Shaw and Gerace).

Also, Gerace discloses targeting users based on the display characteristics or capabilities of the display device (Rejection above; Fig. 3c; and below citation):

“(18) Also for each user, there is a User Computer Object 37b and a User Interface Object 37c. For each user's computer, User Computer Object 37b provides an indication of the limitations and capabilities of the user's computer system. For example, User Computer Object 37b lists whether the user's system provides audio and/or video display, and what Web browser software is utilized by the user's system. An outline of the table/data set of a User Computer Object 37b in the preferred embodiment is illustrated in FIG. 3c” (col 6, lines 11-21).

Additionally, Shaw renders obvious the features of pre-populating at least one field of the advertisement with address location information relating to the user of the hand-held device.

And, Shaw's application is oriented towards advertisements and e-mail, “Electronic Mail System with Advertising” (Title) and:

“(19) The present invention is directed to a disconnected electronic mail system that displays targeted advertisements. More particularly, the present invention allows users to view advertisements while receiving, composing, and managing personal electronic communications” (col 3, lines 10-15).

Gerace further discloses advertisements related to e-mail and also a part of e-mail/messages:

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“Program 31 transmits notices and warnings both internally during execution/operation of program 31 and through E-mail.

(42) In either case (user generated message or system notice/warning), advertisements are allowed to be integrated. To accomplish this, the "Message/Notice Page" format 45 indicates an advertisement package ID (explained below).” (col 10, lines 40-51).

Hence, the prior art renders obvious that advertising can be related to e-mail.

Also, Examiner notes that Applicant’s claims state, “pre-populating. . .with address location information.” Hence, the address location information can be the general address/mailling address of the user. The address location information, as the claim is written, need not be the current address of the user as to where the user is presently.

Hence, the combination of the prior art renders obvious pre-populating at least one field of the advertisement with address location information relating to the user of the hand-held device.

Shaw discloses that an advertisement/e-mail can have fields automatically filled in and that the filled in fields can be a variety of information (including the message), and that user identification information can be included in the pre-filled information as well as other pre-filled information:

“(39) By clicking on the banner advertisement 800, the user may be provided with an e-mail message template to create an e-mail message (as described in connection with FIG. 12 below), having the addressee already filled in with the e-mail address of a company associated

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with the subject matter of the current banner advertisement 800. In this manner, the user may, for example, provide comments to the company regarding the subject matter of the banner advertisement 800 or request further information. Alternatively, clicking on the banner advertisement 800 may cause an e-mail message to be automatically completed (including the message) and either transmitted immediately or stored in the user's "outbox" folder (described later). The message may merely identify the user to the addressee of the e-mail message as someone interested in the subject matter of the banner advertisement 800 (col 13, line 55-col 14, line 5).

Shaw further discloses that user address information is information that is known about the user and can also be part of the user profile:

“(23) The first time that the client computer software is executed on the client computer 101 (and whenever a user wishes to establish a new account with the server system 104), the client program performs various function intended to establish a new account for the user. In the representative embodiment, the first step is to collect new account information (step 301). At the request of the client program, the user inputs name, address, telephone number and other identification data. This information is stored on storage device 206” (col 11, lines 48-60).

Also, note that “other identification data” can also be collected. Also, note that user address information is part of information that can be used to identify a user. For example, “John Doe at 555 Grant Street, Rockville, NJ” is an example of how address information can be used to further identify a user.

Shaw further discloses that user information (including the address information from above) can be sent with an email/advertisement:

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“(30) The user's responses (i.e., the completed member profile) are stored on the client computer 101 storage device 206 for future transmission to the server system 104. In the representative embodiment, the member profile is transmitted to the server system 104 when the user first sends or receives e-mail. . .The member profile can be updated by the user and will then be transmitted to the server system 104 when the user next connects with the server system 104 to sent or receive e-mail messages” (col 12, lines 46-60);

(32) It will be appreciated that in alternative embodiments, the member profile may be transmitted to the server system 104 at step 304 along with the selected e-mail address and password” (col 12, lines 62-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that user address information can be sent along with the pre-filled email. One would have been motivated to do this in order to provide relevant user information for better identification, profiling, and tracking of the user.

Hence, the combination of the prior art renders obvious pre-populating at least one field of the advertisement with address location information relating to the user of the hand-held device.

Additionally, Shaw discloses utilizing the Internet and connecting to the Internet in a variety of manners (col 1, line 45-col 2, line 5).

Shaw does not explicitly disclose:

“wherein the advertisement is at least a portion of a web page, wherein the at least a portion of the web page was generated such that a format of the at least a portion of the web page

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is customized based on at least one of a screen size of the hand-held device, a color depth of the hand-held device, buttons available on the hand-held device, and a network connectivity of the hand-held device”.

However, Gerace discloses a User Computer Object and adapting the content presented to the user's particular device (Figure 3c; col 6, lines 13-22; col 5, lines 15-26; col 12, lines 42-55).

And, Buckingham (6,961,776) discloses these features:

“wherein the advertisement is at least a portion of a web page, wherein the at least a portion of the web page was generated such that a format of the at least a portion of the web page is customized based on at least one of a variety of particular features of the particular hand-held device (Abstract; Figures 1, 2, 3; col 1, line 10-col 3, line 10; col 3, lines 60-67; claims 1, 5, 13).

Therefore, it would be obvious that other features of a user's particular device can be adapted for. And, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gerace and Buckingham's customizing the content for optimal presentation on different devices to Shaw's presenting of content utilizing the Internet. One would have been motivated to do this in order to more optimally present content over the Internet.

Claim 7, 22: Shaw discloses the method of claim 1. Shaw further discloses that a base fee is paid by an advertiser for having the advertiser's advertisement displayed on the device (col 6, lines 35-40).

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Claim 9, 24: Shaw discloses the method of claim 1. Shaw further discloses that the advertisement displayed on the device is targeted for specific users by the advertiser, wherein advertiser targeting of specific users comprises the steps of:

- (a) receiving an advertisement with user preferences,
- (b) identifying users that match the user preferences; and
- (c) loading the advertisement on devices of users identified in step (b) (col 2, lines 40-50; col 5, lines 5-16).

Claim 10, 25: Shaw discloses the method of claim 9. Shaw further discloses that the advertisement is loaded on devices of users in real time (col 2, lines 13-24).

Claim 11, 26: Shaw discloses the method of claim 9. Shaw further discloses that the advertisement is loaded on devices of users during a subsequent sync operation (col 2, lines 25-32).

5. Claims 3, 5, 18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw (6,516,341) in view of Gerace (5,848,396) in view of Buckingham (6,961,776) in view of Goldhaber (5,794,210).

Claim 3, 5, 18, 20: Shaw and the combination of the prior art disclose the method of claim 1.

Shaw discloses charging a fee to an advertiser (col 6, lines 35-40).

Shaw does not explicitly disclose that a fee is paid by the advertiser for each pre-populated address field forwarded to the advertiser.

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Goldhaber discloses charging per item(s) of content about a user provided to the advertiser (col 6, line 60-col 7, line 10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goldhaber's charging per item(s) of content about a user provided to the advertiser to Shaw's charging fees to an advertiser. One would have been motivated to do this in order to better charge for services or information relevant to an advertiser.

Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw (6,516,341) in view of Gerace (5,848,396) in view of Angles (5,933,811) in view of Bandera (6,332,127) in view of Goldhaber (5,794,210).

Claim 50: Please see the rejection of claims 3, 5, 18, 20 preceding.

6. Claims 8, 23 and 46-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw (6,516,341) in view of Gerace (5,848,396) in view of Buckingham (6,961,776) in view of Bandera (6,332,127).

Claim 8, 23: Shaw and the combination of the prior art disclose the method of claim 1.

Shaw further discloses :

(a) accessing a user profile associated with the user of the device;

(c) selecting one or more advertisements based on one or more of the user profile; and

(d) transmitting the one or more advertisements selected in step (c) to the device (col 2, lines 40-50; col 5, lines 5-16).

Shaw discloses tracking at what time the user is presented certain content:

“(16) Accordingly, there exists a need for a targeted advertisement system that also

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can provide information as to the characteristics of those who were exposed to each advertisement, for how long the user was exposed, and at what times “(col 2, lines 54-59).

Shaw does not explicitly disclose time and location based targeting.

However, Bandera discloses targeting a user and targeting a user for advertising based on location and time (col 8, lines 50-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Bandera’s targeting based on location and time to Shaw’s targeting and time tracking. One would have been motivated to do this in order to better target a user with relevant advertising.

Bandera further discloses advertisements with varying format capabilities:

“(6) The Web server 24 is configured to dynamically generate a requested Web page 26 using a dynamic execution engine (DEE) 28 and one or more Web page content objects. The DEE 28 defines the selection of content objects within the Web page and the layout of those content objects within the Web page 26 when displayed within a Web client (i.e., Web browser). Conventionally, each element of a Web page, including, but not limited to, divisions, sections, headings, paragraphs, images, lists, tables, and hyperlinks, may be represented by a content object. In addition, a content object may include audio and video files. It is understood, however, that a single content object may represent one or more of these Web page elements. Dynamic generation of Web pages is well understood by those skilled in the art and need not be described further herein” (col 4, line 60-col 5, line 10).

Claims 46-54: Please see the rejection of the independent claims above and also the rejection of claims 8 and 23 above.

In regards to claim 46, 49, 51, 52, 53, 56, Shaw discloses off-line advertising (col 1, lines 9-14; col 2, lines 37-41; col 5, lines 28-35). Shaw discloses targeted content/advertising based on user information (col 5, lines 6-15). Shaw does disclose targeting the user based on time of day (col 19, lines 53-60). Shaw discloses collecting user address/location information (col 11, lines 48-59). Shaw discloses providing offline, targeted content that includes location relevant or location specific information (col 5, line 60c-ol 6, line 5). Notice in this citation that the information is downloaded to Shaw and that the information includes the location of dealers.

Shaw does not explicitly disclose targeting based on a users current/recent location.

However, Bandera discloses providing targeted content based on the time and/or location of a user or the distance of a user from a point of interest (Figures 2, 6; Abstract; col 6, line 40-col 9, line 46; col 8, lines 45-51, 'vicinity'; col 7, lines 30-40, 'near'; col 9, lines 30-41, 'nearest').

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Bandera's targeting based on current/recent location and time to Shaw's targeting based on various information including time, user address, and locations of interest to the user. One would have been motivated to do this in order to better provide the user with information of geographic relevance/interest.

Also, in regards to claim 47, 48 and 54, 55, Gerace further discloses tracking past locations (col 16, lines 30-36; col 5, line 61-col 6, line 13) and future locations for targeting purposes (col 16, lines 36-55). Notice that Shaw and Gerace uses information on the user's

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initial/original address for targeting purposes. Also, Gerace continually tracks the user's zip codes and Gerace uses all past and current information known about a user for targeting purposes. And, Gerace also uses travel plan information to target a user. Shaw would utilize the information of Gerace and Bandera for better targeting of users.

7. Claims 57, 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw (6,516,341) in view of Gerace (5,848,396) in view of Buckingham (6,961,776) in view of Angles (5,933,811).

Claims 57, 58: The combination of the prior art discloses the above.

Shaw does not explicitly disclose enabling a user of the device to conduct business with a provider, wherein revenue from said business is shared between the provider and a server that enables access to the provider.

However, Angles discloses sharing revenues between involved parties and that a purpose of advertising is inciting purchasing (col 4, lines 25-47; col 2, lines 30-35).

Angles further discloses both website providers and online/internet service providers (col 4, lines 16-46).

Additionally, Angles discloses that an advertisement provider credits an internet provider account:

“The advertisement provider computer also credits a consumer account, a content provider account and an internet provider account each time a consumer views a custom advertisement. Furthermore, the advertisement provider computer tracks consumer responses to the customized advertisements.” (Abstract)

Angles discloses that the advertisement provider is attempting to incite the user towards a purchase and that advertisements present or lead to purchasing/buying opportunities:

“(12)... As the number of people accessing the Internet increases, it will become more important to specifically target advertising to those individuals most likely to purchase the goods or services being offered. It will also be important for advertisers to know how effective a particular ad has become by tracking the responses of individual consumers (col 2, lines 30-40);

(22) The invention also supports custom advertisements which can contain hyper-links to other information. The hyper-links typically direct the user's Internet browser to access different websites on the Internet. For example, if a consumer wishes to obtain additional information about an advertised product or service, the consumer may simply use a mouse to select an embedded hyper-link in the custom advertisement and be immediately transported to an advertiser's website. At the advertiser's website, the user may receive a directed sales pitch, more information or a purchase order request form (col 4, lines 5-16);

(21) Digital Cash. In digital cash commerce, a consumer who maintains an electronic bank account and a payee who maintains an electronic bank account can engage in on-line transactions. When the consumer purchases a good or service with digital cash, the consumer's bank account is automatically debited and the payee's bank account is automatically credited. Likewise, when providing a digital cash refund or transfer, the payee can debit its own bank account while crediting the consumer's bank account (col 6, lines 15-25);

(99) Focusing now on the advertisement database 70 illustrated in FIG. 4, the advertisement database 70 contains numerous advertisements which have been designed for different types of consumers. For example, one version of an advertisement can be directed to selling fruit juice to children. Other versions of the advertisement, can be directed to selling the same fruit juice to teenagers, adults, or different demographic groups. The different versions of the advertisements are organized in the advertisement database 70 into different demographic categories which can be defined by the advertisement provider” (col 15, lines 30-42).

Also, in addition to compensation when a user views an advertisement, Angles discloses that compensation can occur when a user seeks additional information related to particular goods and services, and that the additional information can include purchasing opportunities:

“(137) The advertising module 62 can use such information to determine which advertisements are effective. In addition, the information allows the advertising module 62 to monitor what goods and services the consumer particularly desires. Furthermore, the advertising module 62 can charge the advertisers additional amounts whenever a consumer seeks to obtain additional advertising information. The advertising module 62 can then distribute the revenue as a bonus to the content providers and consumers. This gives the consumers additional incentive to seek more information about advertised goods and services (col 20, lines 25-38);

(100) In addition, in the preferred embodiment, the advertisements are HTML

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compatible, such that an advertisement can contain hyper-links to other information. These hyper-links can contain for example, the URL of another content provider computer 14 which contains more information about the advertised product, sales pitches, electronic catalogs, purchase order forms and the like” (col 15, lines 42-50).

Hence, Angles discloses that an advertisement provider credits an internet provider account, that the advertisement provider provides advertisements that incite purchasing, that compensation can occur when a user seeks more information related to a purchase.

Hence, Angles discloses that the advertisement provider can provide compensation for viewing advertising that is intended to incite a purchase and/or can provide compensation for seeking further information/purchasing opportunities related to advertising that is intended to incite a purchase. Hence, it would be obvious to one skilled in the art that the compensation/revenue sharing can be provided upon an actual purchase. One would be motivated to do this because the purpose of the advertising is incite an actual purpose and because, after a purchase, there are additional funds with which to compensate/share.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Angles revenue sharing to reduce costs to Shaw’s charging for advertising that incite purchases. One would have been motivated to do this in order to better distribute and compensate for costs.

Response to Arguments

8. Applicant's arguments with respect to the claims have been considered but are moot in grounds of the rejection above. Additionally, Examiner notes the below.

In Applicant's Remarks dated 6/20/2007, Applicant states that the combination of the prior art does not render obvious:

“wherein the advertisement is at least a portion of a web page, wherein the at least a portion of the web page was generated such that a format of the at least a portion of the web page is customized based on at least one of a screen size of the hand-held device, a color depth of the hand-held device, buttons available on the hand-held device, and a network connectivity of the hand-held device”.

However, Gerace discloses targeting users based on the display characteristics or capabilities of the display device (Rejection above; Fig. 3c; and below citation):

“(18) Also for each user, there is a User Computer Object 37b and a User Interface Object 37c. For each user's computer, User Computer Object 37b provides an indication of the limitations and capabilities of the user's computer system. For example, User Computer Object 37b lists whether the user's system provides audio and/or video display, and what Web browser software is utilized by the user's system. An outline of the table/data set of a User Computer Object 37b in the preferred embodiment is illustrated in FIG. 3c” (col 6, lines 11-21).

And, Buckingham (6,961,776) discloses these features:

“wherein the advertisement is at least a portion of a web page, wherein the at least a portion of the web page was generated such that a format of the at least a portion of the web page

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is customized based on at least one of a variety of particular features of the particular hand-held device (Abstract; Figures 1, 2, 3; col 1, line 10-col 3, line 10; col 3, lines 60-67; claims 1, 5, 13).

Also, please see the Rejection of the independent claims above.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Also, it must be presumed that the artisan knows something about the art apart from what the references disclose. *In re Jacobv*, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The problem cannot be approached on the basis that artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from what the references disclose. *In re Jacoby*. Also, the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint of suggestion a particular reference. *In re Bozek*, 416 F.2d 1385, USPQ 545 (CCPA 1969). And,

every reference relies to some extent on knowledge or persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F.2d 656, USPQ 12 (CCPA 1977).

Also, when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.

And, if a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, §103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. KSR Int'l Co. v. Teleflex, Inc., No 04-1350 (U.S. Apr. 30, 2007).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Abkowitz (2001/0041973) and Berger (7,210,100) disclose:

“wherein the advertisement is at least a portion of a web page, wherein the at least a portion of the web page was generated such that a format of the at least a portion of the web page is customized based on at least one of a variety of particular features of the particular hand-held device (Abstract; Figures 1, 2, 4; [7]);


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- c) Hollenberg (6,091,956) discloses utilizing different types of location/GPS systems;
- d) Treyz discloses location based targeting;
- f) Kanojia (2004/0181593) discloses targeting a user based on device characteristics;
- g) Batachia (2002/0082912) discloses targeting a user based on device characteristics.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Arthur Duran
Primary Examiner
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6/26/2007